

Remarks/Arguments

This Amendment is in response to the Office Action mailed July 9, 2008. Claims 1-3, 5-19 and 21-36 are pending in this case. Claims 1-3, 5-19 and 21-36 have been rejected. Claims 1, 2, 6-12, 14-19 and 35 have herein been amended. Claims 3, 5, 13, 21-34 and 36 remain unchanged.

Claims 1 and 2 have been newly rejected under 35 U.S.C. § 101 as not qualifying as a statutory process for not positively reciting the other statutory class to which it is tied. In view of this newly issued rejection, Claims 1 and 2, as well as the other amended claims herein, have been amended to identify the apparatus that accomplishes the corresponding method steps. Accordingly, the rejection under 35 U.S.C. § 101 has been overcome and is no longer applicable.

Applicants respectfully submit that the amendments to the claims herein are being made for the sole purpose of clarifying the claims to overcome the new rejection under 35 U.S.C. § 101, which was made for the first time in the final office action. It is respectfully submitted that these amendments do not raise any new matter or issues which would require any further search or consideration, as the amended claim limitations stating the apparatus that accomplishes the corresponding method steps has been previously set forth and claimed, for example in Claims 24-31. At the very least, the present Amendment places the application in better form for appeal by materially reducing or simplifying the issues on appeal. Accordingly, entry of the Amendment pursuant to 37 C.F.R. § 1.116 is respectfully requested.

With respect to the prior art rejections discussed below, Applicants respectfully repeat and reallege the arguments made in the prior response to the Office Action mailed January 15, 2008 as though fully stated herein. Additionally, Applicants respectfully state as follows.

Claims 1, 2, 5, 15 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Funk et al. (US 6,059,185 A) in view of DiNapoli et al. (US 6,826,445 B2) and further in view of Behera (US 5,287,497). For the following reasons, the Examiner's rejection is respectfully traversed.

It is respectfully submitted that this rejection of Claims 1, 2, 5, 15 and 18 is not applicable, especially in view of the amendments to the claims herein. Specifically, Funk et al. fails to disclose the step of obtaining account number information from a check document via an imaging device associated with a check feeder device, as per amended independent Claims 1, 2 and 18 herein. In Funk et al.'s automated system for encoding the correct check amount onto the face of a deposited check, the account number on the check is read by a magnetic ink character recognition (MICR) reader, not an imaging device. Further DiNapoli et al. does not have an imaging device associated with an automated in-line mailing (AIM) device, and does not associate the check document with the bank statement document via an inserter control system, as per amended independent Claim 1 herein. Behera fails to make up for the deficiencies of Funk et al. and DiNapoli et al. Behera discloses a digital storage/retrieval system and is unrelated to an automated check mailing system (amended independent Claims 1 and 18) or a returned check inserter system (amended independent Claim 2).

Accordingly, the proposed combination does not make obvious Applicants' Claims 1, 2, 5, 15 and 18 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that amended Claims 1, 2, 5, 15 and 18 are allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Funk et al. (US 6,059,185 A), DiNapoli et al. (US 6,826,445 B2) and Behera (US 5,287,497), and further in view of

Cahill et al. (US 5,678,046). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Funk et al. in view of DiNapoli et al. and further in view of Behera does not make obvious Applicants' amended Claim 1, from which Claim 3 depends. Cahill et al. fails to make up for the above identified deficiencies of Funk et al. in view of DiNapoli et al. and further in view of Behera. Cahill et al. merely discloses a method and apparatus for storing and retrieving images of checks or other documents.

Accordingly, the proposed combination does not make obvious Applicants' Claim 3 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claim 3 is allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claims 6-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Funk et al. (US 6,059,185 A), DiNapoli et al. (US 6,826,445 B2) and Behera (US 5,287,497), and further in view of Guiles et al. (US 6,607,190 B1). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Funk et al. in view of DiNapoli et al. and further in view of Behera does not make obvious Applicants' amended Claim 1, from which Claims 6-11 depend, either directly or indirectly. Guiles et al. fails to make up for the above identified deficiencies of Funk et al. in view of DiNapoli et al. and further in view of Behera. Guiles et al. merely discloses an apparatus for providing gap control for a high speed check feeder, and does not disclose an inserter control system.

Accordingly, the proposed combination does not make obvious Applicants' Claims 6-11 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claims 6-11 are allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Funk et al. (US 6,059,185 A), DiNapoli et al. (US 6,826,445 B2), Behera (US 5,287,497), Guiles et al. (US 6,607,190 B1) and further in view of Hass (US 4,088,982). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Funk et al. in view of DiNapoli et al. and Behera and Guiles et al. does not make obvious Applicants' amended Claim 1, from which Claim 12 depends, indirectly. Haas fails to make up for the above identified deficiencies of Funk et al. in view of DiNapoli et al. and Behera and Guiles et al. Haas merely discloses a MICR reader, not an imaging device, for reading the magnetic character code of checks being fed to a sorter, and does not relate to an insertor control system.

Accordingly, the proposed combination does not make obvious Applicants' Claim 12 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claim 12 is allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claim 13 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Funk et al. (US 6,059,185 A), DiNapoli et al. (US 6,826,445 B2) and Behera (US 5,287,497), and further in view of Barasch (US 4,124,186). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Funk et al. in view of DiNapoli et al. and further in view of Behera does not make obvious Applicants' amended Claim 1, from which Claim 13 depends. Barasch fails to make up for the above identified deficiencies of Funk et al. in view of DiNapoli et al. and further in view of Behera. Barasch merely discloses a method and apparatus for xerographically printing a composite record of fixed and variable data.

Accordingly, the proposed combination does not make obvious Applicants' Claim 13 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claim 13 is allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claim 14 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Funk et al. (US 6,059,185 A), DiNapoli et al. (US 6,826,445 B2) and Behera (US 5,287,497), and further in view of Jones et al. (US 6,526,574 B1). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Funk et al. in view of DiNapoli et al. and further in view of Behera does not make obvious Applicants' amended Claim 1, from which Claim 14 depends. Jones fails to make up for the above identified deficiencies of Funk et al. in view of DiNapoli et al. and further in view of Behera. Jones merely discloses a system for finding differences between two computer files and updating the computer files.

Accordingly, the proposed combination does not make obvious Applicants' Claim 14 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claim 14 is allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claims 16, 17, 19 and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cahill et al. (US 5,678,046) in view of Behera (US 5,287,497). For the following reasons, the Examiner's rejection is respectfully traversed.

It is respectfully submitted that this rejection of Claims 16, 17, 19 and 35 is not applicable, especially in view of the amendments to the claims herein. Specifically, neither reference teaches, suggests or discloses the use two distinct imaging devices, i.e., a check imaging device and a bank statement imaging device in a check inserter system or an automated check mailing system, as per.

amended Claims 16, 17, 19 and 35. Cahill et al. discloses a method and apparatus for storing and retrieving images of checks or other documents. Behera discloses a similar digital storage/retrieval system. Neither reference is related to an automated check mailing system or a returned check inserter system.

Accordingly, the proposed combination does not make obvious Applicants' Claims 16, 17, 19 and 35 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that amended Claims 16, 17, 19 and 35 are allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claims 21-23 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cahill et al. (US 5,678,046) in view of Behera (US 5,287,497) and further in view of Smith (US 2,294,809). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Cahill et al. in view of Behera does not make obvious Applicants' amended Claim 19, from which Claims 21-23 and 33 depend, either directly or indirectly. Smith fails to make up for the above identified deficiencies of Cahill et al. in view of Behera. Smith discloses an archaic method and apparatus for the remote verification of checks using a television transmitter and receiver.

Accordingly, the proposed combination does not make obvious Applicants' Claims 21-23 and 33 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claims 21-23 and 33 are allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claims 24-28, 30 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNapoli et al. (US 6,826,445 B2) in view of Cahill et al. (US 5,678,046). For the following reasons, the Examiner's rejection is respectfully traversed.

DiNapoli et al. in view of Cahill et al. does not make obvious Applicants' Claims 24-28, 30 and 31 for the reasons discussed above with respect to DiNapoli et al. and Cahill et al. Specifically, DiNapoli et al. has no imaging devices. Cahill et al. discloses a single imaging device in association with a sorter, and fails to make up for the above identified deficiencies of DiNapoli et al. Cahill et al. merely discloses a method and apparatus for storing and retrieving images of checks or other documents, does not make use of a bank statement in any manner, and does not verify correspondence of account numbers between check documents and/or a bank statement.

Accordingly, the proposed combination does not make obvious Applicants' Claims 24-28, 30 and 31 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claims 24-28, 30 and 31 are allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claims 29 and 36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNapoli et al. (US 6,826,445 B2), Cahill et al. (US 5,678,046) and further in view of Haas (US 4,088,982). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, DiNapoli et al. in view of Cahill et al. does not make obvious Applicants' Claim 24, from which Claims 29 and 36 depend, either directly or indirectly. Haas fails to make up for the above identified deficiencies of DiNapoli et al. and Cahill et al. Haas merely discloses a MICR reader, not an imaging device, for reading the magnetic character code of checks being fed to a sorter.

Accordingly, the proposed combination does not make obvious Applicants' Claims 29 and 36 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claims 29 and 36 are allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claim 32 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cahill et al. (US 5,678,046) in view of Behera (US 5,287,497) and further in view of Funk et al. (US 6,059,185 A) and Barasch (US 4,124,186). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Cahill et al. in view of Behera does not make obvious Applicants' amended Claim 19, from which Claim 32 depends. Funk et al. and Barasch fails to make up for the above identified deficiencies of Cahill et al. in view of Behera for the reasons discussed above with respect to Funk et al. and Barasch.

Accordingly, the proposed combination does not make obvious Applicants' Claim 32 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claim 32 is allowable over the proposed combination. An early notice of allowance is respectfully requested.

Claim 34 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cahill et al. (US 5,678,046), Behera (US 5,287,497) and Smith (US 2,294,809) and further in view of Jones (US 6,526,574). For the following reasons, the Examiner's rejection is respectfully traversed.

As discussed above, Cahill et al. in view of Behera and further in view of Smith does not make obvious Applicants' Claim 21, from which Claim 34 depends. Jones fails to make up for the above identified deficiencies of Cahill et al. in view of Behera and further in view of Smith, for the reasons discussed above with respect to Jones.

Accordingly, the proposed combination does not make obvious Applicants' Claim 34 under the law pertaining to 35 U.S.C. § 103. Applicants respectfully assert that Claim 34 is allowable over the proposed combination. An early notice of allowance is respectfully requested.

It is respectfully submitted that none of the prior art of record, either alone or in combination, fairly teaches, suggests or discloses the novel and unobvious features of Applicants' claims as set forth

herein. Accordingly, Applicants respectfully assert that all of the claims as presented herein are now in condition for immediate allowance. An early notice allowance is respectfully requested.

Any arguments of the Examiner not specifically addressed should not be deemed admitted, conceded, waived, or acquiesced by Applicants. Any additional or outstanding matters the Examiner may have are respectfully requested to be disposed of by telephoning the undersigned.

The Commissioner is hereby authorized to charge any fees which may be required to Deposit Account No.16-0657.

A postcard is enclosed evidencing receipt of the same.

Respectfully submitted,

PATULA & ASSOCIATES, P.C.

A handwritten signature in black ink, appearing to read "C. T. Riggs Jr.", with a stylized flourish at the end.

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